UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTON JOSEPH KRYKA and DAVID ANDREW LAPORTE

Appeal 2008-003654
Application 10/714,122
Technology Center 2100

Decided: September 24, 2009

Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
JEAN R. HOMERE, *Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-15, 17, and 18. The Appellants appeal therefrom under 35 U.S.C. § 134(a) (2006). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

The invention at issue on appeal relates to an improved system and method for storing and retrieving images in a document processing system, wherein the system "utilizes an indexing scheme for an image file, wherein the image file stores a plurality of captured document images for subsequent retrieval on an individual basis, and wherein the indexing scheme uses a self-describing index document having tags that described indexing data for the captured document images." (Spec. 8.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

> 1. A document processing system having at least one computer running system software that interfaces with transport hardware to provide document control and capture document images and document data in various formats, wherein an image file stores a plurality of captured document images for subsequent retrieval on an individual basis, the system including a computer readable storage medium storing the system software, the system software on the medium further comprising:

> instructions for indexing the image file by creating an index file containing indexing data for the captured document images, the index file being in the form of a self-describing document wherein elements describe the indexing data for the

captured document images to allow subsequent retrieval of the
captured document images on an individual basis.

C. REFERENCES

The Examiner relied on the following references as evidence:

| Anderson | US 2004/0015566 A1 | Jan. 22, 2004 |
| Lal | US 6,684,204 B1 | Jan. 27, 2004 |

D. REJECTIONS

Claims 1 and 5 are provisionally rejected on the ground of
nonstatutory obviousness-type double patenting as being unpatentable over
claim 49 of co-pending patent application No. 10/714,121. Although the
conflicting claims are not identical, they are not patentably distinct from
each other for the following reasons:

Claim 49 of Patent Application No. 10/714,121
contain(s) every element of claims 1 and 5 of the instant
application and thus anticipate the claim(s) of the instant
application. Claims of the instant application therefore are not
patently distinct from the earlier patent claims and as such are
unpatentable over obvious-type double patenting. A later
patent/application claim is not patentably distinct from an
earlier claim if the later claim is anticipated by the earlier claim.

(Ans. 4.)

Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Anderson in view of Lal.

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II. ISSUES

Have the Appellants shown error in the Examiner's initial showing of obvious-type double patenting?

Have the Appellants shown error in the Examiner's initial showing of obviousness in the combination of Anderson and Lal? Specifically, have the Appellants shown that Anderson does not teach or would not have suggested to one of ordinary skill in the art capturing a plurality of images for later retrieval on an individual basis using an index in a self-describing document?

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (hereinafter "*KSR*").

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art", *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is

thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS
OBVIOUS-TYPE DOUBLE PATENTING

The Appellants note the provisional rejection, and "will consider filing an appropriate terminal disclaimer in the event that the conflicting claim is patented." (App. Br. 5.) We therefore pro forma affirm the obvious-type double patenting rejection of independent claims 1 and 5 which have not been specifically argued.

35 U.S.C. § 103(a)

From our review of the Appellants' arguments in the Appeal Brief, the Appellants' contentions are phrased in terms of it "appears" rather than

making affirmative statements to specifically address the Examiner's position. (App. Br. 6-8; Reply Br 3.) The Examiner further supports the stated rejection from the Final Rejection in the Answer to address the Appellants' concerns for the plural images to individual retrieval.

The Examiner maintains at page 6 of the Answer that:

> [D]atabase and cycle are manipulated, such as deleting and migrating, by the file management, (sections 308-320) for subsequent retrieval on an individual basis (i.e., capturing any object into any database on either a collective basis or an individual object basis (section 120) and searching the system indexes on the basis of an individual object attribute or combination of object attributes (section 130), wherein the object teaches an image . . . .

The Examiner identifies that an image database storing images and associated information obtained from each check in a database for manipulation by a file management for subsequent retrieval on an individual basis is taught and suggested by section/paragraph [0120] of Anderson. We agree with the Examiner that Anderson teaches this well-known use of image acquisition of individual images or image acquisition on a "collective basis." Clearly, Anderson foresees that the image data would be retrievable from the database for later usage and/or manipulation as discussed by the Examiner respect to independent claim 49. (Ans. 6.)

In responsive arguments at pages 10-11 of the Answer, the Examiner maintains that Anderson teaches an index file for the captured items index in paragraph [0131] and teaches the database indexed in paragraph [0787] and [0788] for indexing and teaches image file that stores a plurality of captured document images. Additionally, the Examiner further emphasized that paragraph [0120] of Anderson teaches that a file management system is used

for a database of plural items for subsequent retrieval on an individual basis.
The Examiner maintained that capturing of an object into any database on
either a collective basis or an individual object basis is taught in paragraph
[0120] and searching the system indices on the basis of an individual object
attribute or combination of object attributes is taught in paragraph [0130].
Anderson further teaches that an object may be image in Table 1A and
teaches an index is for query in retrieval in paragraph [0131]. (Ans. 10-11).

     In response to the Examiner's further clarification of the teachings of
Anderson regarding paragraphs [0131] and [0120], the Appellants merely
state that:

>   Section 131 mentions a captured items Index. There
> does not appear to be any discussion of an index file indexing
> and image file that stores a plurality of captured document
> images for subsequent retrieval on an individual basis as
> claimed.
>   . . . .
>
>   Section 120 describes a front-end routine for routing
> different objects to different databases. Again, Andersons still
> as shortcomings.

(Reply Br. 2.) The Appellants, however, do not identify what the
shortcomings are.

     We find the Appellants' mere restatement of the claim language is not
a specific argument for patentability to distinguish the claimed invention and
further does not show error in the Examiner's line of reasoning as set forth
in page 7 of the Answer.

     Clearly, Anderson teaches an image file stores a plurality of images
and the Examiner relied upon portions in paragraphs [0120] and [0131] to
teach or suggest either an individual capture or collective capture basis and

subsequent routing individual objects to different databases based upon accompanying index data.

Hence, to capture and then subsequently route individual objects Anderson would have needed to process and index the data in a manner to carry out the recited function.

The Appellants argue that Anderson's shortcomings are more significant than what is acknowledged by the Examiner. "In particular, Anderson does not appear to describe an index file for an image file that stores captured document images for subsequent retrieval on an individual basis, let alone describe an index file in the form of a self-describing document." (App. Br. 7.) As acknowledged by the Examiner, Anderson does not teach or suggest a self-describing document, and the Appellants argued the totality of the limitations for the individual reference rather than the limited teachings as relied upon by the Examiner in the rejection. Therefore, the Appellants do not address the Examiner's rejection.

The Appellants further argue that "Anderson does not appear to describe an index file for an image file that stores captured document images for subsequent retrieval on an individual basis, let alone describe an index file in the form of a self-describing document." (App. Br. 7.)

Again, the Appellants reiterate claim language which sets forth a desired outcome of a system with no structure or claimed process to achieve the desired functional end result. Furthermore, reiterating the claim language and the Appellants' belief that the reference appears not to teach this does not show error in the Examiner's proffered showing of obviousness. Therefore, the Appellants' argument is not persuasive of error.

With respect to the teachings of Lal, the Appellants argue the totality of the claim language while the Examiner has relied upon Lal for a limited teaching concerning the self-describing document. (App. Br. 8-9.) The Appellants argue that Lal is about indexing an XML document collection, and conducting a search on a network which includes documents having a plurality of tags. (App. Br. 8.) The Appellants argue that "there is clearly no suggestion of an index file in the form of a self-describing document." (*Id.*) The Appellants identify no specific interpretation for "self-describing document" in the art or in the Appellants' Specification to show error in the Examiner's reliance upon the teachings of Lal.

The Appellants further argue that the hash table index does contain the names of tags that occur in the XML documents; however, the hash table is only a table of names and pointers (that is, an object or data structure containing pointers), and is "certainly not a document let alone the fact that the claims specifically require a self-describing document." (App. Br. 9.) The Appellants further argue that the tree index does contain the names of tags that occur in the XML document, and does reflect the basic structure of the XML document in the document type definition associated with the XML document. Nevertheless, the tree index is simply a treatment acts containing pointers (that is, an object or data structure containing pointers). (*Id.*) "The tree index is certainly not a document let alone the fact that the claims specifically require a self-describing document." (*Id.*)

The Examiner relies upon the teachings of Lal that discloses the use of documents with XML tags and document type definitions (DTDs) (Lal. Fig. 5; Cols 2, 4 and 5; Ans. 12-14.) The Examiner maintains that the XML tags in Lal are self-describing. (*Id.* 13.) We agree with the Examiner's rationale

and find no express limitations in the language of independent claim 1 which persuades us otherwise, and the Appellants have identified no special interpretations in light of the Appellants' Specification with which to interpret the language of claim 1. Therefore, the Appellants' argument is not persuasive of the error in the Examiner's initial showing of obviousness.

The Appellants argue that while the hash table index and the tree index do function as indices for XML documents, they are not a "document", let alone the fact the claims specifically require a "self-describing document." (App. Br. 9; Reply Br. 4.) Again, claim 1 does not set forth any express limitations of the "document", nor have the Appellants identified any express definition in the Specification with which to interpret the claim language to show error in the Examiner's interpretation and application of the prior teachings. Therefore, the Appellants have not shown error in the Examiner's initial showing of obviousness.

The Appellants argue that the hash table index and the tree index do not suggest an index file in the form of self-describing documents. (App. Br. 9; Reply Br. 4.) Again the the Appellants' argument does not distinguish why the hash table index or tree index may not be considered a "document", nor does it address any specific interpretation of the claim language to show error in the Examiner's interpretation. The Appellants argue that the hash table index and the tree index, as illustrated, are in the form of object to or data structures-not documents, and clearly not self-describing documents, and even if there were "a suggestion to serialize the hash table index, or the tree index, to create a byte stream for a file, there is no suggestion that the resulting byte stream (file) would represent the index file in the form of a self-describing document or even in the form of a document at all." (App.

Br. 9-10.) The Appellants' argument regarding serializing the data goes beyond the express language of independent claim 1. Furthermore, claim 1 does not set forth any express limitations of the "document", nor have the Appellants identified any express definition in the Specification with which to interpret the claim language to show error in the Examiner's interpretation and application of the prior teachings. Therefore, the Appellants have not shown error in the Examiner's initial showing of obviousness.

     With respect to the Examiner's motivation for the combination, the Appellants state that the Appellants believe that there is no motivation took upon the references to achieve the claimed invention. (App. Br. 10; Reply Br. 5.) The Appellants' belief, however, does not show error in the Examiner's statement for the combination. Therefore, the Appellants' argument is unpersuasive of error in the Examiner's initial showing of obviousness of independent claim 1, and we sustain the rejection thereof.

     With respect to claims 2-15, 17, and 18, the Appellants have set forth no separate arguments for patentability of claims 2-15, 17, and 18. Therefore, we will group these claims with independent claim 1, and sustain rejection thereof.

V. CONCLUSION

     For the aforementioned reasons, the Appellants have set forth no argument with respect to the Examiner's obvious-type double patenting rejection and have not shown error therein. The Appellants have not shown error in the Examiner's initial showing of obviousness of independent claim 1; and the Appellants have not shown that Anderson does not teach or would not have suggested to one of ordinary skill in the art capturing a plurality of

images for later retrieval on an individual basis using an index in a self-describing document.

VI. ORDER

We affirm the obvious-type double patenting rejection of claims 1 and 5, and affirm the obviousness rejection of claims 1-15, 17, and 18.

<u>AFFIRMED</u>

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